

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: A. J. Paul Carew, et al.
Serial No.: 09/724,714
Filing Date: November 28, 2000
Confirmation No.: 7701
Group Art Unit: 2617
Examiner: Inder P. Mehra
Title: SYSTEM AND METHOD FOR COMMUNICATING
 -- TELECOMMUNICATION INFORMATION FROM A
 TELECOMMUNICATION NETWORK TO A
 BROADBAND NETWORK

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

In response to the Advisory Action mailed January 31, 2007, Applicant respectfully requests a Pre-Appeal Brief review of this Application so that the rejection of the claims and the objections to the Application can be reconsidered prior to submission of an Appeal Brief.

REMARKS

This Request for Pre-Appeal Brief Review is being filed in accordance with the provisions set forth in the Official Gazette Notices of July 12, 2005 and January 10, 2006. Pursuant to the Official Gazette Notices, this Request for Pre-Appeal Brief Review is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

Claims 58-114 currently stand objected to as being indecisive and indefinite for the use of the term "operable" in the claim language. Claims 58-65, 67, 72-79, 81, 89-95, and 99-106 stand rejected under 35 U.S.C. §102(e) as being anticipated by Focsaneanu, et al. Claims 66, 68-71, 80, 82-88, 96-98, and 107-114 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Focsaneanu, et al. in view of various cited references. In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish a prima facie case of obviousness. To assist the Panel in the review of this Request for Pre-Appeal Brief Review, Applicant submits the following brief summary for consideration.

In the Advisory Action of January 31, 2007 and the Final Action of November 15, 2006, the Examiner indicates that the use of the term "operable" is language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. However, there is no language in the claims remotely suggesting that any limitation is optional. The Examiner has yet to show how the claims provide any optional aspect. The term "operable" merely describes what functions each element is to perform in order to achieve the desired result. Limitations following the term "operable" in a particular claim element constitute operations

that the claim element is capable of performing. Operations that a claim element is capable of performing are limitations, because the element is thus distinguished from the prior art that is incapable of performing the operations. Moreover, the term "operable" is a commonly used term in patent application claims and is present in claims of numerous patents issued by the United States Patent and Trademark Office. A search in the claims field of the United States Patents Database produced well over 145,000 issued patents that include the term "operable" in the claims. Thus, the use of the term "operable" provides decisiveness and definiteness to the claims.

The Examiner also indicates that the Focsaneanu, et al. patent discloses a common bus between the access module (gateway) and the CPE connector. However, the bus between the access module and a particular CPE connector in the Focsaneanu, et al. patent is for a particular subscriber and thus not common to multiple subscribers. The claimed invention provides for a common bus within its gateway. There is no disclosure in the Focsaneanu, et al. patent that its access module, equated by the Examiner as the claimed gateway, uses a common bus. In fact, the access module of the Focsaneanu, et al. patent uses individual line interfaces 236, 256 each dedicated to a local access connection between the access module and separate CPE connectors. (See FIGURE 8 of the Focsaneanu, et al. patent). Thus, no information from multiple subscribers is ever placed on a common bus between a particular CPE connector and the access module let alone between elements within the access module of the Focsaneanu, et al. patent itself as required by the claimed invention. In addition, the packet assembly/disassembly device 254 of the Focsaneanu, et al. patent is not connected to a common bus carrying first and second telecommunication information from respective first and second subscribers. The packet

assembly/disassembly device 254 of the Focsaneanu, et al. patent is on a line card dedicated to a single subscriber. Thus, the packet assembly/disassembly device 254 of the Focsaneanu, et al. patent cannot receive first and second telecommunication information from first and second subscribers let alone on a common bus as required by the claimed invention.

Since the Focsaneanu, et al. patent does not teach each and every limitation of the claimed invention, Applicant respectfully submits that Claims 58-65, 67, 72-79, 81, 89-95, and 99-106 are not anticipated by the Focsaneanu, et al. patent. In addition, the other references cited by the Examiner do not include any additional disclosure combinable with the Focsaneanu, et al. patent that would be material to patentability of these claims. Therefore, Applicant respectfully submits that all pending claims are patentably distinct from the Focsaneanu, et al. patent and any combination of cited references proposed by the examiner.

CONCLUSION

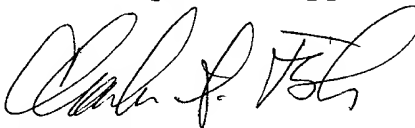
Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read 'Charles S. Fish', is written over the printed name.

Charles S. Fish

Reg. No. 35,870

February 15, 2007

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